3764
#7 / Reconsideration 10.11.01

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants:	Beth N. Grijalva	Group Art Unit:	3764
Serial No.:	09/594,445	Examiner:	L. Hamilton
Filed:	June 15, 2000		
For:	Eye Patch	Atty. Dkt. No.:	GRIJ-0002-US

Commissioner for Patents
Washington, DC 20231

REPLY TO OFFICE ACTION DATED JULY 30, 2001

Dear Sir:

In an Office Action mailed on July 30, 2001, claims 1-8, 8-20 and 22-24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Oviatt in view of Grindle; and claims 7, 21 and 45 were rejected to as being dependent upon a rejected base claim but allowable if rewritten in independent form. These rejections are respectively traversed, as discussed below.

The Examiner has failed to establish a *prima facie* case of obviousness for at least two reasons. First, to establish a *prima facie* case of obviousness, "there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings." M.P.E.P. § 2143. This requirement has not been met, as the Examiner fails to cite language from any of the cited references to support this suggestion or motivation, and the Examiner fails to allege such knowledge to exist in the general level of skill in the art. It is noted that "rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment." *All-Site Corp. v. VSI Int'l, Inc.*, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999).

A *prima facie* case of obviousness has not been established for the additional reason that, as pointed out in the last Reply, at least one of the references (Grindle) teaches away from the combination. The Examiner states that one of the § 103 references is a "primary" reference and

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I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as **first class mail** with sufficient postage on the date indicated above and is addressed to the Commissioner for Patents, Washington, DC 20231.
Debra Cutrona
Debra Cutrona

the other § 103 reference is a "secondary" reference. However, labeling the references in this manner is irrelevant, as references cannot be combined where a reference teaches away from their combination. M.P.E.P. § 2145(X)(D)(1); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). Furthermore, not only do the references teach away from their own combination, but Grindle teaches away from the claimed invention, contrary to a suggestion or motivation to combine Grindle with Oviatt to derive the claimed invention.

Thus, for at least these reasons, the claims overcome the § 103 rejections.

CONCLUSION

In view of the foregoing, the Assignee requests withdrawal of the § 103 rejections and a favorable action in the form of a Notice of Allowance. The Commissioner is authorized to charge any additional fees under 37 C.F.R. § 1.16 and § 1.17, or credit any overpayment to Deposit Account No. 20-1504 (GRIJ-0002-US).

Respectfully submitted,

Date 7/28/04

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